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09/518,403	03/03/2000	Hisato Shima	SONY-C7751	7367
22850	7590	02/02/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			ONUAKU, CHRISTOPHER O	
			ART UNIT	PAPER NUMBER
			2615	

DATE MAILED: 02/02/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/518,403

Applicant(s)  
Shima et al

Examiner  
Christopher O. Onuaku

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2615



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other:

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## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,298,196

Regarding claim 12 claim 1 of the U.S. Patent No. 6,298,196 cite the features of claim 12 of this application including a copyright protection method wherein copyright protection information provided in a transmission header of a transmission frame and detecting whether the digital recording apparatus performs processing in compliance with the copyright protection information, and allowing the digital signal to be received by the digital recording apparatus in response to a detection that the digital recording apparatus performs processing in compliance with the copyright protection information.

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Although the conflicting claims are not identical, the features of claim 12 of current application are obvious over the pertinent features of claim 1 of US Patent 6,298,196 because features of claim 12 of current application are broader and encompass the pertinent features of claim 1 of US Patent 6,298,196.

3. Claim 13 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,298,196

Regarding claim 13 claim 1 of the U.S. Patent No. 6,298,196 cite the features of claim 13 of this application including wherein the digital recording apparatus receives the digital signal via an interface based on an IEEE 1394 format.

Although the conflicting claims are not identical, the features of claim 13 of current application are obvious over the pertinent features of claim 1 of US Patent No. 6,298,196 because features of claim 13 of current application are broader and encompass the pertinent features of claim 1 of US Patent No. 6,298,196.

4. Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,298,196

Regarding claim 14, claim 2 of the U.S. Patent No. 6,298,196 cite the features of claim 14 of this application including a copyright protection method wherein if the digital recording apparatus is a recording apparatus having hardware which does not perform processing of data in

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compliance with the copyuright protection information, the transmission frame is supplied to the digital recording apparatus only when the copyright protection information indicates copy free.

Although the conflicting claims are not identical, the features of claim 14 of current application are obvious over the pertinent features of claim 2 of US Patent 6,298,196 because features of claim 14 of current application are broader and encompass the pertinent features of claim 2 of US Patent 6,298,196.

5. Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,298,196

Regarding claim 15, claim 3 of the U.S. Patent No. 6,298,196 cite the features of claim 15 of this application including a copyright protection method wherein if the digital recording apparatus is a recording apparatus having hardware which performs processing of data in compliance with the copyuright protection information, based upon the copyright protection information a digital interface detects whether the copyright protection information included in content of the transmission frame indicates the compliance, and if so, the copyright protection information in the content is acquired based on signal format type information of the transmission header.

Although the conflicting claims are not identical, the features of claim 15 of current application are obvious over the pertinent features of claim 3 of US Patent 6,298,196 because

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features of claim 15 of current application are broader and encompass the pertinent features of claim 3 of US Patent 6,298,196.

6. Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,298,196

Regarding claim 16, claim 1 of the U.S. Patent No. 6,298,196 cite the features of claim 16 of this application including a copyright protection apparatus comprising means for detecting copyright protection information provided in a transmission header of a transmission frame of a digital signal to be inputted to the digital recording apparatus, means for detecting whether the digital recording apparatus performs processing in compliance with the copyright protection information, wherein in response to a detection that the digital recording apparatus performs processing in compliance with the copyright protection information, the digital signal is provided to the digital recording apparatus.

Although the conflicting claims are not identical, the features of claim 16 of current application are obvious over the pertinent features of claim 1 of US Patent 6,298,196 because features of claim 16 of current application are broader and encompass the pertinent features of claim 1 of US Patent 6,298,196.

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7. Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,298,196

Regarding claim 17, claim 1 of the U.S. Patent No. 6,298,196 cite the features of claim 17 of this application including wherein the digital recording apparatus receives the digital signal via an interface based on an IEEE 1394 format.

Although the conflicting claims are not identical, the features of claim 17 of current application are obvious over the pertinent features of claim 1 of US Patent No. 6,298,196 because features of claim 17 of current application are broader and encompass the pertinent features of claim 1 of US Patent No. 6,298,196.

8. Claim 18 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,298,196

Regarding claim 18, claim 8 of the U.S. Patent No. 6,298,196 cite the features of claim 18 of this application including a control IC for controlling a link layer of a digital interface comprising means for detecting copyright protection information provided in a transmission header of a transmission frame of a digital signal inputted through the digital interface, and means for receiving the transmission frame and for allowing recording by a digital recording apparatus if the copyright protection information indicates copy free.

Although the conflicting claims are not identical, the features of claim 18 of current application are obvious over the pertinent features of claim 8 of US Patent No. 6,298,196

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because features of claim 18 of current application are broader and encompass the pertinent features of claim 8 of US Patent No. 6,298,196.

9. Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,298,196

Regarding claim 19, claim 9 of the U.S. Patent No. 6,298,196 cite the features of claim 19 of this application including a control IC for controlling a link layer of a digital interface comprising wherein the control IC is mounted on the digital recording apparatus, the control IC further comprising switching means for supplying the transmission frame to the digital recording signal processing section only when the copyright protection information indicates copy free.

Although the conflicting claims are not identical, the features of claim 19 of current application are obvious over the pertinent features of claim 9 of US Patent No. 6,298,196 because features of claim 19 of current application are broader and encompass the pertinent features of claim 9 of US Patent No. 6,298,196.

10. Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,298,196

Regarding claim 20, claim 10 of the U.S. Patent No. 6,298,196 cite the features of claim 19 of this application including a control IC for controlling a link layer of a digital interface comprising wherein the control IC is mounted on the digital recording apparatus, the control IC

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further comprising a processor for detecting, based on the copyright protection information, whether the copyright protection information included in content of the transmission frame indicates compliance, and means for acquiring the copyright protection information in the content based on the signal format type information in the transmission header if the processor detects compliance.

Although the conflicting claims are not identical, the features of claim 20 of current application are obvious over the pertinent features of claim 10 of US Patent No. 6,298,196 because features of claim 20 of current application are broader and encompass the pertinent features of claim 10 of US Patent No. 6,298,196.

11. Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,298,196

Regarding claim 21, claim 11 of the U.S. Patent No. 6,298,196 cite the features of claim 21 of this application including a copyright protection apparatus comprising means for detecting copyright protection information provided in a transmission header of a transmission frame of a digital signal to be inputted to the digital recording apparatus, means for detecting whether the digital recording apparatus performs processing in compliance with the copyright protection information, wherein in response to a detection that the digital recording apparatus performs processing in compliance with the copyright protection information, the digital signal is provided to the digital recording apparatus.

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Although the conflicting claims are not identical, the features of claim 21 of current application are obvious over the pertinent features of claim 11 of US Patent 6,298,196 because features of claim 21 of current application are broader and encompass the pertinent features of claim 11 of US Patent 6,298,196.

12. Claim 22 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,298,196

Regarding claim 22, claim 11 of the U.S. Patent No. 6,298,196 cite the features of claim 22 of this application including wherein the digital recording apparatus receives the digital signal via an interface based on an IEEE 1394 format.

Although the conflicting claims are not identical, the features of claim 22 of current application are obvious over the pertinent features of claim 11 of US Patent No. 6,298,196 because features of claim 22 of current application are broader and encompass the pertinent features of claim 11 of US Patent No. 6,298,196.

13. Claim 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,298,196

Regarding claim 23, claim 14 of the U.S. Patent No. 6,298,196 cite the features of claim 23 of this application including a control IC for controlling a link layer of a digital interface comprising means for detecting copyright protection information provided in a transmission

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header of a transmission frame of a digital signal inputted through the digital interface, and means for receiving the transmission frame and for allowing recording by a digital recording apparatus if the copyright protection information indicates copy free.

Although the conflicting claims are not identical, the features of claim 23 of current application are obvious over the pertinent features of claim 14 of US Patent No. 6,298,196 because features of claim 23 of current application are broader and encompass the pertinent features of claim 14 of US Patent No. 6,298,196.

14. Claim 24 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of U.S. Patent No. 6,298,196

Regarding claim 24, claim 15 of the U.S. Patent No. 6,298,196 cite the features of claim 24 of this application including a control IC for controlling a link layer of a digital interface comprising wherein the control IC is mounted on the digital recording apparatus, the control IC further comprising switching means for supplying the transmission frame to the digital recording signal processing section only when the copyright protection information indicates copy free.

Although the conflicting claims are not identical, the features of claim 24 of current application are obvious over the pertinent features of claim 15 of US Patent No. 6,298,196 because features of claim 24 of current application are broader and encompass the pertinent features of claim 15 of US Patent No. 6,298,196.

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15. Claim 25 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of U.S. Patent No. 6,298,196

Regarding claim 25, claim 16 of the U.S. Patent No. 6,298,196 cite the features of claim 25 of this application including a control IC for controlling a link layer of a digital interface comprising wherein the control IC is mounted on the digital recording apparatus, the control IC further comprising a processor for detecting, based on the copyright protection information, whether the copyright protection information included in content of the transmission frame indicates compliance, and means for acquiring the copyright protection information in the content based on the signal format type information in the transmission header if the processor detects compliance.

Although the conflicting claims are not identical, the features of claim 25 of current application are obvious over the pertinent features of claim 16 of US Patent No. 6,298,196 because features of claim 25 of current application are broader and encompass the pertinent features of claim 16 of US Patent No. 6,298,196.

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an

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application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claims 12,14,15,16&21 are rejected under 35 U.S.C. 102(e) as being anticipated by Kori et al ( US 5,778,064).

Regarding claim 12 Kori et al disclose in Fig.7&8 apparatus and method for processing a high definition video signal having copy prevention information method comprising:

a) in a header information of a transmission frame of the digital signal to be transmitted, a copyright information is contained and the copyright information restricts recording of the digital signal to be inputted to the digital recording apparatus, wherein the copyright information comprises copy free information for indicating to the digital recording apparatus that the digital signal is copy free; and information for indicating to the digital recording apparatus to perform copy management in compliance with a copyright information included in the content of the transmitted transmission frame ( see the Fig.4&5; col.4, lines 43-62; CGMS data stored in VAUX and AAUX data packs, respectively wherein the CGMS data is stored as bits and is defined as follows:

00: Valid copy operation ("first" copyright information)

01: Not used

10: Valid for only 1 copy operation (partially copy protected) ( "second" copyright information)

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11: Invalid copy operation (fully copy protected) ("second" copyright information):

b) detecting copyright protection information provided in a transmission header of a transmission frame of a digital signal to be inputted to the digital recording apparatus (see auxilliary data processing circuit 15 of VTR 1), detecting whether the digital recording apparatus performs processing in compliance with the copyright protection information (see auxilliary data processing circuit 15 of VTR 2), and allowing the digital signal to be received by the digital recording apparatus in response to a detection that the digital recording apparatus performs processing in compliance with the copy protection information (see Fig.6, VTR 1 which operates to reproduce a digitally recorded HD video signal from a magnetic tape; and VTR 2 which operates to record a HD video signal onto a magnetic tape, wherein the HD data is embedded with the CGMS copy protection data; col.5, line 15 to col.6, line 9);

Regarding claims 14&15, the claimed limitations of claims 14&15 are accommodated in the discussions of claim 1 above.

Regarding claim 16, the claimed limitations of claim 16 are accommodated in the discussions of claim 12 above, except for the claimed interface means ( see Fig.7, digital interface 22; col.6, line 10 to col.7, line 60; and Fig.4&5; digital interface 41; col.4, line 43 to col.5, line 14).

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Regarding claim 21, the claimed limitations of claim 21 are accommodated in the discussions of claims 12&16 above, including the claimed "first" detector (see auxiliary data processing circuit 5 of VTR 1 and "second" detector (see auxiliary data processing circuit 15 of VTR 2), as discussed in claim 12 above.

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 18-20&23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kori et al in view of Tamada et al ( US 5,729,717).

Regarding claim 18, Kori et al disclose the claimed limitations of claim 18 ( see claim 1 discussions, including the receiving means and the controlling means in Fig.8; col.7, line 4 to col.8, line 52). Kori et al fail to disclose a control IC. In the same field of endeavor, Tamada et al teach IC card and issuing apparatus which is a portable data storing/processing device connectable through a terminal device to a main data processing device comprising a portable main body, a memory of which memory area is segmented into a plurality of zones for storing data supplied to the main body, and an access controller for storing access condition for each zone of the memory to control the access to each zone. An IC chip is contained in a card 10 (see

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Fig. 1), a connector 12 is provided on the surface of the card, so that when the card 10 is inserted into a user terminal device, the connector 12 connects the IC chip with such a device. As shown in Fig.2, the IC chip includes a CPU 20, a zone access controller 22 which is an EEPROM and stores a password and an access condition for each zone of a memory 24 in the form of a zone access table ( see Table I in col.2), an encrypt circuit 26, an interface 28, and the memory 24 which is an EEPROM for storing a control program for the CPU 20. At the user terminal, after insertion of the IC card, a password is input by the card owner. It is sequentially checked whether or not each zone is accessible by the user terminal and the owner. Then, only the accessible zones are open to use by the owner ( see Fig. 1-5; and col.2, line 14 to col.4, line 45). Here, Tamada teaches the use of an IC to control the access to information and service which provides a portable data storing/processing device which is versatile in use to control access to information and service. It would have been obvious to one of ordinary skill in the art to modify Kori by providing as an IC, as taught by Tamada, the copy protection device of Kori, which would then make the Kori device portable and versatile in use as a copy protection device.

Regarding claim 19, the claimed limitations of claim 19 are accommodated in the discussions of claims 12&18 above.

Regarding claim 20, the claimed limitations of claims 20 are accommodated in the discussions of claims 12&18 above.

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Regarding claim 23, the claimed limitations of claim 23 are accommodated in the discussions of claim 18 above.

Regarding claim 24, the claimed limitations of claim 24 are accommodated in the discussions of claim 19 above.

Regarding claim 25, the claimed limitations of claim 25 are accommodated in the discussions of claim 20 above.

20. Claims 13,17&22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kori et al in view of Cloutier et al ( US 5,847,771).

Regarding claims 13,17&22, Kori fails to disclose a digital interface based on IEEE 1394 format. Cloutier et al, in the same field of endeavor, teaches bus interface 66 which is a high speed two way interface that supplies the primary program in MPEG2 format in parallel with ATM cell streams output from the ATM selector bank 64. The bus interface 66 operates in accordance with the published standard IEEE 1394 ( see Fig.3&4; and col. 10, lines 41-53). It would have been obvious to one of ordinary skill in the art to modify Kori by realizing Kori with a digital interface, as taught by Cloutier, which interface is based on IEEE 1394 standard and which interface provides a high speed interface.

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***Conclusion***

21. Any inquiry concerning this communication or earlier communications from this examiner should be directed to Christopher Onuaku whose telephone number is (703) 308-7555. The examiner can normally be reached on Tuesday to Thursday from 7:30 am to 5:00 pm. The examiner can also be reached on alternate Monday.

If attempts to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Andrew Christensen, can be reached on (703) 308-9644.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

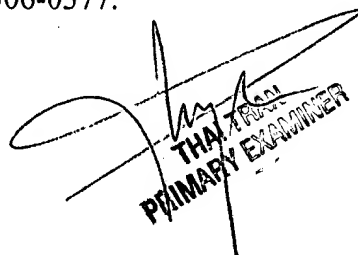
and (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be direct to the Group receptionist whose telephone is (703) 306-0377.

  
COO

1/23/04

  
THAI TRU  
PRIMARY EXAMINER